

REMARKS

With the entry of the present Amendment, claims 1-4, 6-13, and 19-27, 29-35 and 37-39 are in this application. Claims 28 and 36 are cancelled without prejudice in the present amendment, and the limitations thereof have been incorporated into claims 24 and 27. None of the amendments made herein constitutes the addition of new matter.

Allowable Subject Matter

Claims 1-4, 6-13, 19-23 and 30-35 have been allowed.

The Rejection under 35 U.S.C. 112, first paragraph

Claims 24-29 and 36-39 have been rejected under 35 U.S.C. 112, first paragraph as allegedly failing to comply with the written description requirement. Applicant respectfully traverses this rejection.

The Patent Office has characterized the claims as drawn to a genus of methods of transforming any organism with the recited transposable element, and to any non-human transformant obtained using that method using Class II transposable elements as the inverted repeats. The Specification is characterized as showing reduction to practice of transposition of a piggyBac-based transposon in *Drosophila*. No other structures or transposable elements or host organisms containing such are said to be disclosed. The Patent Office has asserted that transposable elements are known only to a few taxonomic groups and as such, knowledge in the art across all living organisms is very incomplete.

In the interest of advancing prosecution and without acquiescing to the rejection, Applicant has amended claim 24 and 27 to recite insects. The level of skill in the art of genetic modification of insects is high, and insect transposable elements are known to the relevant art. In response to the Patent Office statement that there is only reduction to practice in *Drosophila* for the piggy Bac-based transposon, Applicant respectfully responds that other transposons are well known, and *Drosophila* is a popular, accepted model system for genetic modification and molecular biological studies in insects. See, for example, Handler et al. (2001) *Insect Biochem. Mol. Biol.* 31:111-128 (already of record) and other references cited by Applicant in Information Disclosure Statements for this application for a discussion of transposons and organisms, especially insects, in which they are useful for genetic modifications. See also page 16, for example, where

Applicant has stated that the methods of the present application are useful in a wide range of organisms. It is obvious that Applicant viewed his invention as applicable to more than just piggyback and *Drosophila*, and it is abundantly clear to one of ordinary skill in the art reading the Specification and claims that the Applicant **was** in possession of the invention as claimed. Note that there is no statutory requirement for any particular number or type of examples.

In view of the discussion provided above and the amendments to the claims, Applicant respectfully submits that the skilled artisan, upon reading the present claims and description, will readily understand that Applicant is in possession of the invention as claimed. Accordingly, it is maintained that the present application is in compliance with the written description of Section 112, first paragraph, and the rejection should be withdrawn.

Conclusion

It is submitted that this case is in condition for allowance, and passage to issuance is respectfully requested.

If there are any outstanding issues related to patentability, the courtesy of a telephone interview is requested, and the Examiner is invited to call to arrange a mutually convenient time.

This Amendment is accompanied by a Petition for Extension of Time (one month) and payment of the fee required by 37 C.F.R 1.17(a) via the Electronic Filing System. It is believed that no other fees are due and that no further extension of time is necessary. If this is incorrect, however, please deduct the correct fee, and any fee required for any further extension of time, if needed, from Deposit Account 07-1969.

Respectfully submitted,

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